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REMARKS

Claims 14-38 are currently pending in the subject application and are presently under consideration. Independent claims 14 and 21 have been amended herein to emphasize various aspects of the claimed invention. Claims 35-38 are presented to emphasize additional aspects of the present invention. A clean version of all pending claims is found at pages 2-5. Favorable consideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 21-24, 28, 29, and 31, 32 Under 35 U.S.C. § 103(a)

Claims 21-24, 28, 29, and 31, 32 stand rejected under 35 U.S.C. §103(a) as being obvious over Petteruti *et al.* (U.S. 5,335,170). Withdrawal of this rejection is respectfully requested for at least the following reason.

Petteruti *et al.* does not teach or suggest all limitations recited in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done. *Ex parte Levengod*, 28 USPQ2d 1300 (P.T.O.B.A.&I. 1993).

The present invention relates generally to hand-held data acquisition devices. More specifically, the present invention is directed to data acquisition devices *with*

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improved ergonomic arrangement whereby operation of a keypad is supported against the main portion of a user's hand to provide more stable support as compared with conventional devices.

In particular, as recited in independent claim 21, the subject invention provides for a hand-held optical scanning device having a body including an optical scanning module arranged to scan objects in a direction outward from a first distal end, the body including an upper surface having a display mounted thereof, and a handle that extends from a bottom surface of the body at the first distal end to increase a viewing angle of the display, the handle being joined to the body to cause a proximal end of the bottom surface of the body to rest on a radial surface of a user's hand to provide support. Such features of applicants' claimed invention are neither taught nor suggested by the cited reference.

The Final Office Action dated December 16, 2004 incorrectly contends that Petteruti *et al.* discloses the limitations recited in independent claim 21 (and claims 22-24, 28-29 and 31-32 depending there from). Rather, Petteruti *et al.* is directed to a modular and portable system adapted to provide inventory control functions comprising a programmable master module including a display, a keypad, and processing electronics, and a scanning module for reading bar code symbols, where the master module is interconnectable with the scanning module to form a portable scanner for reading and analyzing bar code symbols, and the master module is adapted to interconnect to a plurality of other modules such as a printer module, an interface module, and a suitcase module. (*See, Petteruti et al., Abstract.*)

The Final Office Action asserts that Petteruti *et al.* discloses "a handle 42 that extends from a bottom surface of the body (see Figure 2A). The handle 42 being joined at a selected angle with respect to the body. The handle extends from the bottom surface of the body at the first distal end (see Figure 2A) such that the bottom surface of the body rests on a radial surface of a user's hand when the user grasps the handle." (*See Office Action, pg. 3, ln. 8-11.*) Applicants' representative respectfully disagrees.

Other than the Examiner's personal interpretation of Figure 2A, the Examiner fails to cite a specific reference within Petteruti *et al.* for such contention. In lieu of

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citing a specific reference, the Examiner simply assumes that "Figure 2A shows a portion (e.g., the proximal end of the body) of the scanner's body extending outward toward user such that when user grabs the handle, the upper portion of the body (e.g. the proximal end of the body) would rest on the upper surface of the user's hand." (See Office Action, pg. 10, ln. 7-10). Applicants' representative respectfully submits that such assumption is incorrect let alone improper. Rather, Petteruti *et al.* is silent with regard to any such weight distribution or support onto a user's hand.

Moreover, Figure 2A of Petteruti *et al.* does not specifically disclose, teach or suggest that the upper portion would necessarily rest on the user's hand as incorrectly asserted in the Office Action. Such conclusion apparently is formulated solely upon conjecture and 20/20 based hindsight with respect to Figure 2A in view of applicants' disclosure.

More particularly, the Final Office Action relies on improper hindsight in reaching an obviousness determination. The Federal Court has held that to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988) (citations omitted).

Rather, Figure 2A of Petteruti *et al.* merely indicates that "the proximal end of the body of the scanner's body (e.g. the head portion 44 and the master module 10 combined) **would extend over the radial surface of the user's hand** upon a gripping position of the handle by the user." Clearly, the mere suggestive positioning "**over the radial surface of the user's hand**" does not disclose, teach or suggest that the proximal end of the body would rest on the user's hand as set forth in applicants' claimed invention.

As earlier stated, Petteruti *et al.* is silent with regard to any such weight distribution or support onto a user's hand. In fact, Petteruti *et al.* suggests that "when mated together via the interconnectors 38 and 48, the laser scanning module 12 and the master module 10 form a light-weight, stand-alone, portable, hand-held, programmable,

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micro-processor-controlled laser scanning device 50 capable of, for example, reading and analyzing bar code symbols." (See Petteruti *et al.*, col. 2-3, ln. 68-6). Applicants' representative respectfully submits that it is more accurate to rely upon the written specification of Petteruti *et al.*, as set forth above, than to attempt to improperly assume the purported intention of Petteruti *et al.* from the figures (*e.g.*, Figure 2A).

A prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983, cert. denied, 469 U.S. 851 (1984). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why an artisan would have found the claimed invention in light of the teachings of the reference." *Ex Parte Clapp*, 227 USPQ 972,973 (Bd. Pat. App. & Inter. 1985).

Here, applicants' representative respectfully submits that the "light-weight" reference set forth in the specification of Petteruti *et al.* clearly teaches away from any interpretation leading one to believe that Petteruti *et al.* discloses, teaches or suggests that the hand-held device was designed to be supported by a user's hand. Moreover, the Federal Circuit has held that teaching away from the art of the subject invention is a *per se* demonstration of a lack of *prima facie* obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

In contrast to Petteruti *et al.*, independent claim 21 of the present invention specifically recites, in part, an arrangement where *a bottom surface of a scanner's body rests on a user's hand*. In other words, when an operator employs applicants' claimed hand-held scanner, a portion of the *scanner's body* extends onto the radial surface of the user's hand (*e.g.*, the hand's radial surface provides a support that facilitates weight distribution of the scanner during operation).

Independent claim 21 further recites *a handle that extends from a bottom surface of the body at the first distal end to increase a viewing angle of the display*. As compared with conventional placement of the display, applicants' claimed invention

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positions the display closer to the operator and increases a viewing angle formed by the plane of display surface and operator's line of sight.

The rationale proffered to modify Petteruti *et al.* is to achieve benefits identified in applicants' specification, which overcomes problems associated with conventional systems/methods. Applicants' representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants' specification. Such rationale has been condemned by the CAFC. *See Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

For at least the foregoing reasons, it is readily apparent that Petteruti *et al.* fails to teach or suggest all the claimed aspects of the subject invention. Accordingly, independent claim 21 (and claims 22-24, 28-29 and 31-32 depending there from) is believed to be in condition for allowance. Withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 14-17, 20, and 33-34 Under 35 U.S.C. § 103(a)

Claims 14-17, 20, and 33, 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti *et al.* in view of Tracy *et al.* (U.S. 5,979,757). Withdrawal of this rejection is respectfully requested for at least the following reason. The Examiner cites Tracy *et al.* in an attempt to cure the aforementioned deficiencies of Petteruti *et al.* However, Tracy *et al.* is not citable prior art with respect to the present application. The following is a quotation of 35 U.S.C. §103(c) which forms at least one basis for withdrawal of this rejection:

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (e), (f), and or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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The subject matter of Tracy *et al.* and the claimed invention were, at the time the invention was made, owned by the same person. Telxon and Symbol Technologies share common ownership. Therefore, Tracy *et al.* is not a citable reference with respect to the subject application.

Furthermore, Petteruti *et al.* and Tracy *et al.*, alone or in combination, do not disclose, teach or suggest applicants' claimed invention. Independent claim 14 has been amended herein to emphasize various aspects of the claimed invention. As amended, independent claim 14 (and similarly independent claim 21) recites a handle that extends from *a bottom surface* of the body, the handle being joined to the body *to cause the bottom surface of the body to rest on a surface of a user's hand to facilitate stability and weight distribution*. Petteruti *et al.* does not teach or suggest such claimed features as noted *supra* with respect to independent claim 21. Moreover, Tracy *et al.* does not make up for the aforementioned deficiencies of Petteruti *et al.*

In view of at least the above comments, it is respectfully submitted that the rejection of independent claim 14, claims 15-17, 20 dependent therefrom, and claims 33, 34 which depend from independent claim 21 should be withdrawn.

III. Rejection of Claims 18- 19, 25-27, and 30 Under 35 U.S.C. § 103(a)

Claims 18, 19, 25-27, and 30 stand rejected under 35 U.S.C. §103(a) as being obvious over Petteruti *et al.* as modified by Tracy *et al.* as applied to claim 14, and further in view of Reynolds *et al.* (U.S. 5,828,052). Withdrawal of this rejection is respectfully requested for at least the following reasons. Tracy *et al.* is not a proper citable reference. Additionally, Petteruti *et al.* as modified by Tracy *et al.* and Reynolds *et al.* alone or in combination, do not teach or suggest applicants' claimed invention.

Claims 18-19 and claims 25-27 and 30 depend from independent claims 14 and 21 respectively. Reynolds *et al.* does not make up for the aforementioned deficiencies of Petteruti *et al.*, alone or in combination with Tracy *et al.* with respect to the independent claims. Thus, the subject invention as recited in independent claims 14 and 21 (and claims 18-19, 25-27 and 30 depending there from) is not obvious over Petteruti *et al.* as modified by Tracy *et al.*, and further in view of Reynolds *et al.* Accordingly, withdrawal of this rejection

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is respectfully requested.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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